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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,759	05/04/2001	Geroge Ann Pieters	00-053	2676

7590

09/10/2003

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EXAMINER

BOYD, JENNIFER A

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/849,759	PIETERS, GEROGEANN	
	Examiner	Art Unit	
	Jennifer A Boyd	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 7, 10 - 16, 19 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 7, 10 - 16, 19 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 page                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Applicant's Amendments and Accompanying Remarks, filed June 10, 2003, have been entered and have been carefully considered. Claims 8, 9, 17, 18 and 20 – 23 are cancelled, claims 1, 2, 15 and 24 are amended and claims 1 – 7, 10 – 16, 19 and 24 are pending. In view of the Applicant's Remarks, the Examiner withdraws the 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection of claims 1 - 23 as set forth in paragraphs 1 - 5 of the previous Office Action dated December 19, 2002. In view of Applicant's amendments, the Examiner withdraws the 35 U.S.C. 102(b) rejection of claims 1 - 24 as being anticipated by Takahashi as set forth in paragraph 7 of the previous Office Action dated December 19, 2002. However, after a new search, the Examiner has found additional prior art when renders the invention as currently claimed unpatentable.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 7, 10 – 16, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (US 5,928,778) in view of O'Dell (US 5,866,209).

Takahashi teaches a decorative material which is excellent in flexibility and abrasion

Art Unit: 1771

resistance (Abstract). The decorative material of this invention can be used for various purposes such as decorating surfaces of buildings, vehicles, ships, furniture, musical instruments, cabinets and decorating wrapping materials (column 11, lines 50 – 55).

As to claims 1, 15 and 24, Takahashi teaches a material including a substrate and an abrasion resistant coating layer. Takahashi teaches that substrate can be a paper, plastic film or sheet, or metallic foil or plate (column 1, lines 66 – 67). It is preferable to use a flexible material as the substrate (column 2, line 5). Takahashi teaches that the substrate can be a composite substrate which can be obtained by laminating two or more substrates by any known means, for instance, by the use of an adhesive agent, or by effecting thermal fusion (column 2, lines 66 – 67 and column 3, lines 1 – 3). The composite substrate comprising two or more substrates is equated to Applicant's "inner protective layer", "base material", "bonding material", "decorative material" and "outer decorative layer". Takahashi teaches that substrate can be a paper, plastic film or sheet, or metallic foil or plate (column 1, lines 66 – 67). Examples of the types of paper are tissue paper, craft paper, titanium paper, linter paper, cardboard, plasterboard paper, raw fabric of so-called vinyl wall paper, high-grade paper, coated paper, art paper, vegetable parchment, glassine paper, animal parchment, paraffin paper and Japanese paper. In addition, paper-like sheets can be used as the substrate such as woven or nonwoven fabrics produced from inorganic fibers such as glass fiber, alumina fiber, silica fiber and carbon fiber or organic fibers such as polyester of Vinyon (column 2, lines 15 – 27). A plastic sheet can be used as a substrate in the form of an acrylic film (column 2, lines 36-37). Due to the fact that a composite substrate can be used, one embodiment of Takahashi, a composite substrate of 4 layers can be used. For instance, Takahashi teaches a "base material" bonded to an "inner protective layer", a "bonding

Art Unit: 1771

material" bonded to the second side of the base material, a "decorative layer" such as a paper or a paper-like sheet bonded to the "base material" and an abrasion resistant coating layer, or "outer protective layer", on the opposing side of the "decorative layer". In one embodiment of Takahashi, the "inner protective layer", the "bonding material" and "outer protective layer" can be comprised of acrylic film (column 2, lines 37 - 40).

Takahashi teaches that the substrate can be a composite substrate which can be obtained by laminating two or more substrates by any known means, for instance, by effecting thermal fusion (column 2, lines 66 - 67 and column 3, lines 1 - 3). Therefore, in the embodiment where the "inner protective layer", the "bonding material" and "outer protective layer" are acrylic films, any application of thermal fusion to the acrylic films would bond the "base material" and the "decorative layer" together to create the desired composite of the Applicant.

However, as to claims 1, 15 and 24, Takahashi fails to teach that acrylic films which bind the layers together can be ~~in the~~ can be in the form of an aqueous acrylic polymer dispersion medium which is applied wet and bonds upon drying.

O'Dell is directed to a process for producing aesthetic surface layer composition. O'Dell teaches that decorative laminates have been conventionally made by stacking a plurality of layers of paper impregnated with thermosetting resins such as acrylic. Conventional laminates are made of three essential layers: a core layer, a decorative layer and surface layer (column 1, lines 20 - 35). The resin can be in the form of an aqueous dispersion of polymer particles in water (column 3, lines 25 - 33). The decorative laminate is coated and impregnated on an exterior surface at a rate which results in all the sheets being saturated and, afterwards, dried (column 7, lines 28 -

Art Unit: 1771

45). It should be noted that acrylic is inherently water resistant and translucent as required by claims 5 – 7 and 19.

It would have been obvious to one of ordinary skill in the art to use the aqueous dispersion of acrylic polymer as suggested by O'Dell to create the composition of Takahashi motivated by the desire to completely saturate the composite in a single step operation creating a durable composite.

As to claims 2 and 3, Takahashi teaches that the “base material” can be made out of a paper-like sheet such as a nonwoven comprising fibers such as carbon or alumina fibers (column 2, lines 21 – 26), which are known in the art to be high in strength.

As to claim 4, Takahashi teaches that the substrate can be a composite substrate which can be obtained by laminating two or more substrates, therefore, an additional paper-like layer such as a “woven backing” could be attached to the “base material”.

As to claims 10, 11 and 16, Takahashi teaches that the “decorative layer” can be comprised of paper. Vegetable parchment paper among other papers (column 2, lines 14 – 26) typically has a textured finish and can have a generally random wrinkled pattern. Takahashi also notes that is possible to use a substrate having a rough or three-dimensional pattern (column 2, lines 9 – 14).

As to claim 12, Takahashi teaches that the “decorative layer” can be a board such as veneer (column 2, lines 45 – 50), which has a hard finish.

As to claim 13, Takahashi teaches that the “decorative layer” can be a paper such as vegetable parchment paper (column 2, lines 14 – 26), which has a smooth or calendared finish.

Art Unit: 1771

As to claim 14, Takahashi teaches that the “decorative layer” can be a paper-like material such as a woven fabric comprising alumina and carbon fibers (column 2, lines 21 – 27). A paper-like material implies a smooth or semi-smooth surface, therefore, the woven fabric would have to be woven tightly to give a smooth appearance. The “decorative layer” would have a hard finish due to fiber content of high strength rigid fibers.

### *Response to Arguments*

4. Applicant's arguments with respect to claims 1 – 7, 10 – 16, 19 and 24 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

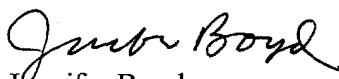
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1771

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Jennifer Boyd  
September 4, 2003

